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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,121	01/24/2001	Preston H. Abbott	17243-00020	5556

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3692

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/769,121	ABBOTT ET AL.	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication of July 27, 2005. Requirement of Election of Species is withdrawn by the examiner in view of the persuasive arguments presented to Mr. Vincent Millin (examiner's ex-supervisor) during a telephone conversation on February 23, 2006. Applicants election of claims 24-49 with traverse in their communication of July 27, 2005 is acknowledged by the Examiner. Accordingly claims 1-23 are withdrawn from consideration are being drawn to a non-elected invention. Applicants are respectfully requested to cancel the non-elected claims 1-23 in response to this office action. Arguments for restricting the claims were presented in the office action mailed on October 11, 2005. Claims 24-49 have been examined. The objections and rejections are stated below.

Drawings

2. The drawings submitted with this application are objected to by the examiner. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 24-49 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 24-49 are rejected under 35 U.S.C. § 101 for failing to produce useful, concrete and tangible result. Claim 24 recites a system with a server configured to approve sellers of goods and commodities according to a seller participation agreement and approve buyers of goods and commodities according to a buyer participation agreement; a network connecting said at least one computer to said server; and a user interface allowing a user to input and receive information relating to the buying and selling of the goods and commodities , that doesn't produce a “useful, concrete and tangible result”.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101

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judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77.

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. Claims 25-49 are rejected for the same reason and by way of dependency on a rejected independent claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 24-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claim 24 recites “a system for executing and financing transactions of goods and commodities for a parent company through a wholly owned financing subsidiary and a wholly owned trading subsidiary”. However it is not clear from the body of the claims as to how this objective is achieved. Hence the scope of the claim is not clear. Claims 25-49 are rejected by dependency on claim 24. Appropriate clarification/correction is required.

Claim 24 recites “a user interface allowing a user to input and receive information”. However it is not clear as to what is the relationship between this interface and the server or the

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at least one computer. It is also not clear if the user interface is coupled to the network. In view of these ambiguities the scope of the claim is unclear. Claim 24 also recites “information relating to the buying and selling of the goods and commodities”. There is no antecedent basis for this limitation. Claims 25-49 are rejected by dependency on claim 24. Claim 25 recites the limitation “said server is further configured to facilitate securing of capital”. It is not clear what the facilitating function entails. The metes and bounds of this limitation are not clear. Applicant is requested to correct/clarify similar deficiencies in other claims. Claims 26-28 recite the limitation “said server configured to”. It is not clear if the applicant had meant “said server further configured to”. Applicant is requested to check for similar deficiencies in other claims and make appropriate clarification/correction in their response to this office action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell (US Patent 5,940,807).

Claim 24, Purcell teaches a system comprising: at least one computer (See Figure 1); a server configured to approve sellers of goods and commodities according to a seller participation agreement and approve buyers of goods and commodities according to a buyer participation agreement (See Figure 1, Column 1 lines 35-45, Column 3 line 51 – Column 4 line 5, the host is

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the server and the written documentation for placing and filling orders is interpreted to include these agreements); a network connecting said at least one computer to said server (See Column 4 lines 40-46); and a user interface allowing a user to input and receive information relating to the buying and selling of the goods and commodities (See Column 6 line 52- Column 7 line 35).

Purcell does not explicitly teach the objective of “executing and financing transactions of goods and commodities for a parent company through a wholly owned financing subsidiary and a wholly owned trading subsidiary”. However this objective in the preamble is interpreted as intended use of the system and hence not given patentable weight. Purcell’s system has the structure and capability for performing this intended use.

Claims 47-49, Purcell teaches the features wherein the server is further configured to allow a user to input data via the Internet (See Column 4 lines 40-46); to receive user data via an Intranet (old and well known) and network is one of a wide area network and a local area network (See Column 4 lines 40-46, Internet is an example of WAN).

Claims 26-29, Purcell does not explicitly teach the features in these claims. Official notice is taken that these features are old and well known in the art. For instance GM has GMAC for financing and another sub-division for sales. These features provide for a smooth and efficient means for completing the transaction.

Claims 30-46, Purcell teaches the feature of the server further configured to accept input from sellers or buyers (See Column 6 line 52- Column 7 line 35). The limitations such as “a seller agreeing to assign all rights in a shipment to the trading subsidiary” or “buyers agreeing to pay the purchase price to the trading subsidiary for orders within an agreed upon time period by a method and at a place previously agreed to” are interpreted as non-functional descriptive

material because they describe the buyers and sellers. These limitations have no bearing on the server configuration to accept input from sellers or buyers.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Clark (US Patent 6,351,738 B1) (February 26, 2002) Collective Business System

(b) Conklin et al (US Patent 6,338,050 B1) (January 8, 2002) System and Method for Providing and Updating User Supplied Context for a Negotiations System

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian
September 28, 2006